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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/613,964

07/03/2003

Mark Vaughn

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02/28/2008

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INTELLECTUAL PROPERTY ADMINISTRATION
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EXAMINER

OBEID, FAHD A

ART UNIT

PAPER NUMBER

3627

NOTIFICATION DATE

DELIVERY MODE

02/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/613,964 | Applicant(s) VAUGHN, MARK | |
| | Examiner FAHD A. OBEID | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This is in reply to application filed on 12/18/2007.
1. **Claims 1-25** are pending in this application.

The examiner acknowledges applicants submission of new drawings filed on 12/18/2007, and therefore the previous office action's objection with respect to the drawings has been withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Reifel (US 7,013,288).**

4. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:

- Maintaining a print quantity in a server (col 2 lines 5-10 and col 6 lines 20-42).
- The print quantity being associated with a recipient (fig 8 - 9)
- Accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9).
- Implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

5. Regarding Claims 2, 11, 20, and 23: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the image included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of: printing each of the images in the collection of images; and shipping the images to the recipient (figs 8-9, col 13 lines 35-37, col 17 lines 12-16, and col 18 lines 36-48).

6. Regarding Claims 3, 12, 21, and 24: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the images included in the collection of

images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of:

- Transmitting each of the images in the collection of images to a print vendor for printing (col 5 lines 28-30, col 12 lines 17-27, and col 15 lines 55-60)
- Transmitting a ship address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient (figs 4, 5, 7A, col 18 lines 26-29, and col 18 lines 36-48).

7. Regarding Claims 4, 13 and 25: Reifel disclose a method of claim 3, further comprising the step of tracking a total number of the images transmitted to the print vendor for printing (col 9 lines 32-38, col 12 lines 49-62, and col 16 lines 34-37).

8. Regarding Claims 5 and 14: Reifel disclose a method of claim 1, further comprising the step of implementing the printing of the images included in the collection of images upon receipt of an order for immediate printing of the collection of images from the originator (figs 3-5, col 5 lines 45-61, and col 6 lines 37-42).

9. Regarding Claims 6 and 15: Reifel disclose a method of claim 1, wherein the step of accumulating the collection of images received from the originator in the server further comprises the steps of:

- Receiving a number of images from the originator (figs 5 and 8).

- Adding each of the number of images to the collection of images (figs 5 & 8, and col 6 lines 37-42).
- Determining if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of images to the collection of images (col 16 lines 29-37).

10. Regarding Claims 7 and 16: Reifel disclose a method of claim 1, further comprising the step of acknowledging a receipt of a number of images to the originator (col 19 lines 42-51).

11. Regarding Claims 8 and 17: Reifel disclose a method of claim 1, further comprising the step of sending a print notification to the originator when the total number of the images included in the collection of images breaches the print quantity (col 19 lines 42-51).

12. Regarding Claims 9 and 18: Reifel disclose a method of claim 1, further comprising the step of obtaining a payment for the implementation of the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity (fig 8-9, col 5 lines 35-44, col 11 lines 4-6, col 20 lines 50-57).

Response to Arguments

13. Applicant's arguments have been fully considered but are not persuasive. In particular the applicant argues that: a) maintaining a print quantity in a server; b) the print quantity being associated with a recipient; c) accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient; d) implementing a printing of the images included in the collection of images when a total number of the images included in the collection of images breaches the print quantity; e) the concept of only printing images when a print quantity of images are stored in the server where images are uploaded to the server over time.

In response to a) the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Reifel teaches a consumer captures images, upload images, and chooses to print, e-mail, or store the images in a based user directory for friends, family viewing, and print product ordering (figs 5 & 6). Also, figs 8 and 13 clearly show a consumer's account with collections of images stored in a server. Furthermore, Reifel teaches a consumer can order quantity of images (col 14 lines 31-39 and claim 16).

In response to b) the examiner respectfully disagrees. Reifel teaches allowing the consumer to specify that copies of prints should automatically be made for a designated recipient and the method of delivery to the recipient (col 17 lines 12-16); designated users such as family members, friends, business entities, or the like (col 19 lines 7-17).

In response to c) the examiner respectfully disagrees. Reifel teaches a consumer creates an account at a website and uploads images to the server wherein consumer decides which images to print (fig 6, col 2 line 4, col 6 lines 27-31).

In response to d) the examiner respectfully disagrees. Reifel teaches allowing a consumer to specify copies of prints should automatically be made for a designated recipient (col 17 lines 12-16). Also, Reifel teaches an order form is used to specify how many copies of each image reproduction should be made, the consumer can optionally modify the information as needed or desired; further, the consumer can specify that only certain images are to be reproduced, and can specify the type and size of image reproduction of an image-by-image basis (col 18 lines 36-48).

In response to e) applicant's argument that the reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., only printing images when a print quantity of images are stored in the server where images are uploaded to the server over time) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fahd Obeid
Patent Examiner
02/18/2008

/F. Ryan Zeender/
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